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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,595	04/25/2001	Koichi Motoike	206569US2	4759

22850 7590 01/30/2002

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EXAMINER

WELLS, KENNETH B

ART UNIT	PAPER NUMBER
2816	

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/841,595</b>	Applicant(s) <b>MOTOIKE</b>	
	Examiner <b>Kenneth B. Wells</b>	Art Unit <b>2816</b>	
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
<b>Period for Reply</b> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>three</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <p>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</p> <p>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</p> <p>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</p> <p>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</p> <p>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Sep 25, 2001</u></p> <p>2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>			
<b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-11, 13-18, and 20</u> is/are rejected.</p> <p>7) <input checked="" type="checkbox"/> Claim(s) <u>12 and 19</u> is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>			
<b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>Apr 25, 2001</u> is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>			
<b>Priority under 35 U.S.C. § 119</b> <p>13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <p>1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</p> <p>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p> <p>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>			
<p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>			
<b>Attachment(s)</b> <p>15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)      18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)      19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5 and 6</u>      20) <input type="checkbox"/> Other: _____</p>			

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The attempt to incorporate subject matter into this application by reference to applicant's Japanese priority document is improper because it is not an allowed U.S. application or a U.S. patent.

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3. The drawings are objected to because Fig. 1 needs a "prior art" label. Also, all black boxes in the figures need text labels. Correction is required.

4. Claims 2-6 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, there is no antecedent basis for "a second capacitor element" because no first capacitor element has been set forth in claim 1. Note also claim 3 has the same problem with regard to the recitation of the third capacitor element. Also indefinite in claim 2 is "apparently" on line 6. Does this language mean that the parasitic resistance component does not actually decrease?

In claim 4, "configured to switch" is indefinite, i.e., switch what? Also, on line 4 of claim 4, "and" should be changed to --for--. Note also claims 5, 6 and 14-16 have the same problems.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13, 14, 16, 17, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohan, Jr.

The FET is transistor 21, the inductor is element 28 and the capacitor is element 26. The limitation on the last five lines of claim 11 is deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The third capacitor element is capacitor 22. The limitation on the last four lines of claim 13 is deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The control signal input circuit recited in claims 14 and 16 is any of the components, or the supply voltage generating circuitry (not shown), which applies potential to the drain of FET 21.

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The limitations of claims 17 and 18 are deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The bias supply circuit of claim 20 is applied to terminal 15.

6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher.

Note Figs. 1 and 2, where the FET is transistor 12 and the inductor is element 17. The capacitor of claim 2 is capacitor 29, and the capacitor of claim 3 is capacitor 18. The limitations on the last five lines of claim 1, and the last four lines of claims 2 and 3, are deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The control signal input circuit recited in claims 4-6 is any of the components, or the supply voltage generating circuitry (not shown), which applies potential to the drain of FET 12. The limitations of claims 7-9 are deemed to be inherent, since all of the claimed structure is fully anticipated by the reference, see *In re Best*, 195 USPQ 430.

The bias supply circuit of claim 10 is voltage source 15.

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7. Claims 12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth B. Wells whose telephone number is (703) 308-4809. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan, can be reached on (703) 308-4876. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
Kenneth B. Wells  
Primary Examiner  
Art Unit 2816

January 25, 2002